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VIA FACSIMILE NO.: 571-273-8300 (12 pages)

Date: August 22, 2005Attorney Docket No.: 101769-234 tesa 1615-WCG
9500HetaIN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Marc HUSEMANN, et al.
Serial No. : 10/687,494
Filed : October 16, 2003
For : PRESSURE-SENSITIVELY ADHESIVE MOULDINGS
Art Unit : 1713
Examiner : Tatyana Zalukaeva

August 22, 2005

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPELLANTS' BRIEF ON APPEAL PURSUANT TO 37 CFR § 41.37

Sir:

This is an appeal from the final rejection of an Examiner of Art Unit 1713.

1. REAL PARTY IN INTEREST

The instant application is owned by tesa AG, record owner hereof.

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2. RELATED APPEALS AND INTERFERENCES

The undersigned is not aware of any appeals, interferences, reexaminations, infringement actions or the like in any related applications.

3. STATUS OF CLAIMS

The claims pending in this application are claims 1-8; all of said claims are finally rejected and all of said claims are on appeal.

4. STATUS OF AMENDMENTS

The last amendment filed was a Rule 116 Amendment filed April 16, 2005 (by facsimile) and that amendment was not entered.

5. SUMMARY OF THE CLAIMED SUBJECT MATTER

Independent claim 1 relates to a novel moulding comprised of one or more block copolymers based on polyacrylate and having pressure-sensitive adhesion properties (page 2, lines 14-17, 27-28; page 17, lines 6-15).

Independent claim 6 relates to a method for producing the moulding of claim 1 by diecutting (page 17, lines 25-27), compression moulding (page 17, lines 17-22), or by injection moulding (page 17, lines 6-13).

Independent claim 7 relates to a method for bonding substrates with the pressure-sensitive moulding of claims 1, 2, 3 or 4 (page 18, lines 22-24).

Independent claim 8 relates to a sealing material comprising the moulding of claim 1 (page 18, line 20).

6. GROUNDS FOR REJECTION TO BE REVIEWED ON APPEAL

The grounds for rejection to be reviewed on appeal are

A) The rejection of claims 1-8 under 35 USC 102(e) as anticipated by any one of Husemann et al. (US 2003/0013790A1), Husemann et al. (US 2003/0073767A1) or Husemann et al. (US 6,765,078).

B) The rejection claims 1-8 under 35 U.S.C. 102(b) as anticipated by WO/0039233.

7. ARGUMENTS

A) The rejection of claims 1-8 under 35 USC 102(e) as anticipated by any one of Husemann et al. (US 2003/0013790A1), Husemann et al. (US 2003/0073767A1) or Husemann et al. (US 6,765,078).

The Examiner sees Husemann et al. (US 2003/0013790A1) as disclosing pressure sensitive adhesive compositions applied from the hot melt to a background material, and the Husemann et al. (US 2003/0073767A1) and Husemann et al. (US 6,765,078) references as disclosing adhesive materials used as films on supports (Office Action of 01/18/2005, page 3).

The Examiner insists that Appellants have not provided an explicit definition of what is meant by a mould, and that she therefore reads the term "mould" as

encompassing the films disclosed by the references. The Examiner views Appellants' examples as practically describing the same mode as applied by the references.

Contrary to the Examiner's assertions, the meaning of the term "moulding" will be clearly understood by those skilled in the art, based on their own knowledge of mouldings, as well as by the description of mouldings given in the specification and the examples. Appellants' mouldings, as described in the specification and in the examples come nowhere near to the "mode applied by the references".

On page 17, lines 6-29, Appellants describe several techniques for producing the mouldings, such as by injection moulding, compression moulding, blow moulding and roto-moulding. Absolutely no person skilled in the art, having read this, would ever view such mouldings as being in any way the same as or similar to simple films of adhesive, such as those described in the references.

Likewise, Appellants' examples do not describe anything that could be characterized as a film of adhesive, such as those disclosed in the references. In the Examples, Appellants

1. Apply their polymeric product as a coating onto a release paper.
2. The polymeric coating from step 1 above is then applied to both sides of a Saran-primed PET film, which itself had already been coated with the polymeric product, thereby forming a laminate having several layers of the polymeric product.

3. The laminate is then lined with release paper, and pressure sensitive pads are punched out of the laminate.

The Examiner has not shown where anything can be found in any of the references that would teach or suggest any such pads, punched out of a laminate of a plurality of adhesive layers, PET film and release paper.

Each of the references pertains to a pressure-sensitive adhesive material, in and of itself, and none of them have anything to do with mouldings, as described above.

At col. 1, paragraph [0002], Husemann et al. (US 2003/0013790A1) mentions pressure sensitive adhesive compositions as being "...applied from the melt as a polymer film to a backing material." Husemann et al. (US 2003/0073767A1) recites the same use at Col. 1, paragraph [0002], and Husemann et al. (US 6,765,078) likewise refers to the adhesive materials disclosed therein as being used as a film on a support (col. 5, lines 57-58).

None of these references disclose or suggest anything about a moulding comprised of self-adhesive materials. Such mouldings are truly novel and unobvious.

In the Office Action of 01/18/2005, at page 3, 5 lines from the bottom, the Examiner refers to an example at page 9, lines 4-7 of Appellants' specification as "practically describing the same mode as applied references". This Honorable Board

will see, however, that when one reads the cited language, and compares this language to the Examples of the references, a big difference becomes clear. In the so-called example at page 9, Appellants end up laminating 3 strips, each of which has a thickness of 130 g/m^2 . This then produces a moulding of $3 \times 130 = 390 \text{ g/m}^2$. Alternatively, Appellants show 8 strips of 50 g/m^2 , for a total of 400 g/m^2 .

The references, by contrast, all use a coating weight of 50 g/m^2 .

Clearly, there is a difference between the claimed moulded products and the coated products of the references. Those skilled in the art would quickly recognize the difference between the mouldings of the present application and the films of the references.

The rejection of claims 1-8 under 35 U.S.C. 102(e) should accordingly be REVERSED.

B) The rejection claims 1-8 under 35 U.S.C. 102(b) as anticipated by WO/0039233.

As in the previous rejection, the adhesives of WO/0039233 are coatings, not mouldings (page 1, lines 8-9). For the same reasons as given above, this reference cannot possibly anticipate Appellants' mouldings. The language at page 25, lines 1-5, specifically mentioned by the Examiner, refers only to a layer of adhesive compressed

between two release surfaces and cooled to form an adhesive transfer tape. This is nothing like the shaped articles punched out of the multi-layer laminate described in Appellants' examples. The "release surfaces" described in the reference are not further identified, and are not said to remain as a part of the final product. Thus, those skilled in the art would read the "release surfaces" as constituting some kind of a tool, such as a vice, for forming the adhesive into a sheet, which is then separated from the vice. Nothing in this reference comes even close to teaching or suggesting Appellants' mouldings.

The rejection of Claims 1-8 under 35 U.S.C. 102(b) as anticipated by WO/0039233 should accordingly be REVERSED.

8. CONCLUSION

Wherefore it is submitted that the final rejection is in error and should be REVERSED.

AUTHORIZATION TO CHARGE FEE TO DEPOSIT ACCOUNT

Appellant is:

☐ a small entity

☒ other than a small entity

It is requested that the fee for the filing of the Brief on Appeal be charged to the undersigned's Deposit Account No. 14-1263.

9. CLAIMS APPENDIX

The claims are appeal read as follows:

Claim 1. Moulding comprised of one or more block copolymers based on polyacrylate or mixtures comprising such block copolymers, characterized by inherent pressure-sensitive adhesion properties.

Claim 2. Moulding according to Claim 1, wherein the mouldings have a sufficiently high pressure-sensitive adhesion to hold their own weight for at least 30 minutes on at least one material selected from polyethylene, ABS (acrylonitrile-butadiene-styrene copolymers) and/or polystyrene when having been pressed onto a sample surface of said material with an applied pressure of 19.6 N/cm^2 .

Claim 3. Moulding according to Claim 1, wherein the block copolymers have a sequence of at least one polymer block or copolymer block P_H having a glass transition temperature of not more than 10°C and of at least one polymer block or copolymer block P_S having a glass transition temperature of at least 20°C .

Claim 4. Moulding according to Claim 3, wherein the block copolymers comprise at least one triblock structure of the form $P_S-P_H-P_S$ and/or $P_H-P_S-P_H$.

Claim 5. Moulding according to Claim 1, wherein the block copolymers comprise at least one functional group which behaves inertly in a free-radical polymerization reaction and which is capable of promoting a crosslinking reaction of the polymers.

Claim 6. A method of producing the mouldings of Claim 1, which comprises producing said mouldings by diecutting, by compression moulding or by injection moulding.

Claim 7. A method for single-sided or double-sided adhesive bonding of substrates, which comprises bonding said substrates with a moulding of Claim 1, 2, 3 or 4.

Claim 8. A sealing material comprising a moulding of claim 1.

10. EVIDENCE APPENDIX

No evidence under §§ 1.130, 1.131, or 1.132 has been submitted.

11. RELATED PROCEEDINGS APPENDIX

There have been no decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of 37 CFR 41.37

Please charge:

[] \$ 250.00 for small entity

[X] \$500.00 for other than small entity.

CONDITIONAL PETITION FOR EXTENSION OF TIME

If any extension of time for this response is required, appellant requests that this be considered a petition therefor. Please charge the required Petition fee to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess to our Deposit Account No. 14-1263.

Respectfully submitted,

NORRIS McLAUGHLIN & MARCUS, P.A.

By 

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I hereby certify that this correspondence is being transmitted via facsimile, no. 571-273-8300 to the United States Patent and Trademark Office, addressed to: Mail Stop Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on August 22, 2005.

By 

Suzanne Schuster

Date August 22, 2005